

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 18

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RD OF PATENT APPEAL
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARIE ANGELOPOULOS, YUN-HSIN LIAO
and RAVI F. SARAF

Appeal No. 2002-0906
Application 09/346,353¹

ON REQUEST FOR REHEARING

Before KIMLIN, METZ and KRATZ, *Administrative Patent Judges*.
METZ, *Administrative Patent Judge*.

Receipt on November 29, 2002, of the paper captioned
"REQUEST FOR REMAND AND REHEARING" (Paper Number 17) is herein
acknowledged. On page 2 of Paper Number 17, appellants request,
alternatively, that we "remand this application to the examiner"
to afford appellants an opportunity to address "both new grounds

¹ Application for patent filed July 2, 1999. According to the official records of the Patent and Trademark Office (PTO) this application is division of application Serial Number 08/620,631, filed on March 22, 1996, and now U.S. Patent Number 5,969,024, issued on October 19, 1999.

for rejection and new reasons for rejection relating to the above-identified application" or that "the appeal be reheard by this Honorable Board on the same record after considering the arguments presented in this submission."

Nevertheless, in our opinion we expressly affirmed: the obviousness double patenting rejection of claims 1 through 16, 20, 22, 23 and 25; the examiner's rejection of claim 24 under 35 U.S.C. § 112, first paragraph; the examiner's rejection of claims 1 through 16, 20, 22, 23 and 25 under 35 U.S.C. § 102 or, alternatively, 35 U.S.C. § 103; and we reversed the examiner's rejection of claims 40 through 42 under 35 U.S.C. § 112, first paragraph. See pages 11 and 21 of Paper Number 16. Additionally, pursuant to our authority under 37 C.F.R. § 1.196(b), we entered new grounds of rejection of claims 40 through 42 over the prior art on which the examiner relied to reject appellants' claims which rejection we affirmed, and we entered a new rejection of claims 1, 2, 6 through 9, 15, 16, 20, 22, 40 and 41 under 35 U.S.C. § 102 or § 103 over the disclosure of newly cited Eisenbaumer. See page 21 of Paper Number 16.

On page 22 of our decision, we advised appellants, with regard to any affirmed rejection, that:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

and we further advised appellants that, with respect to the new grounds of rejection, appellants must, within two months from the date of our decision, exercise one of the two following options provided for in the rule:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Thus, appellants' request that we remand this application to the examiner would only have been appropriate if appellants had submitted an "appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both." Because appellants have neither proffered an appropriate amendment of the newly rejected claims nor made any showing of facts relating to the new grounds of rejection, remand to the examiner is not available to appellants under the express terms of the rule as explained in our decision. Rather, appellants' entire response is a request that we "rehear"² the appeal of the

² Requests for "rehearing" were denominated as requests for reconsideration under the prior rule. See 37 C.F.R. § 1.197(b) as amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997).

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application based on appellants' arguments as set forth in Paper Number 17. Accordingly, we shall treat appellants' response as a request to "rehear" both the affirmed rejections and the new grounds of rejection.

DECISION ON REHEARING

The second sentence of 37 C.F.R. § 1.197(b) provides that the request for rehearing:

must state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought.

Thus, appellants' request must direct us to the fact, argument or point of law we "misapprehended" or the fact, argument or point of law we "overlooked" in reaching our decision. A request for rehearing is inappropriate where the sole reason for the request is disagreement with the merits of our decision. According to appellants our affirmance was in error "for several reasons." See pages 2 through 11 of Paper Number 17.

DECISION ON REHEARING

In the first paragraph of page 3 of Paper Number 17, appellants allege, without regard to any specific rejection, either an affirmed rejection or any new ground of rejection, that no reference cited by us provides motivation or incentive for removing or partially removing solvent but not additive in

appellants' claimed method. However, we have carefully reviewed appellants' brief and find no argument therein concerning the existence in the prior art of motivation or incentive for removing or partially removing solvent but not additive. Manifestly, we could not have "misapprehended or overlooked" an argument not made by appellants in their brief. Additionally, appellants' argument ignores: our analysis of the prior art as set forth on pages 3 through 6 and 20 through 21; our determination of the scope and meaning of appellants' claims (see pages 8 through 10 of Paper Number 16); our discussion and analysis of the alternative rejections under §§ 102 and 103; and our discussion, analysis and application of newly cited Eisenbaumer as set forth on pages 20 through 21 of Paper Number 16.

On page 3 of their request, in addressing our discussion on page 15 of our opinion of the examiner's rejection of claims 24 and 40 through 42 under § 112, appellants urge that we erroneously found that appellants neither disclose nor exemplify any oxidants. According to appellants' request, "Useful oxidants are well known in the art." Further, appellants direct our attention to page 15 of their specification wherein an example of preparing polyaniline by the oxidative polymerization of aniline is disclosed. According to appellants, because the catalyst used

in the example in the specification is an oxidant, our finding was erroneous. Appellants also cite to U.S. Patent Number 5,008,041 for its disclosure of oxidants and urges the patent is evidence "of oxidants available to the public at the time the invention was filed." See page 3 of Paper Number 17. Appellants conclude by pronouncing that in light of the well-established tenet of patent law with respect to the enablement requirement of § 112 that a patent need not teach and preferably omits that which is well-known in the art, the disclosure in the specification of prior art methods for oxidative polymerization of aniline satisfies the written description requirement of § 112 for the term "oxidant" in claim 24. This argument ignores what we held in our decision, mischaracterizes the scope of claims on appeal and misstates the law.

For purposes of satisfying the enablement requirement of the statute, it has been consistently held that a specification need not be a production manual listing every minute detail on how to prepare the invention claimed and that an applicant for patent need not disclose but preferably omits that which was well-known in the art on how to prepare the claimed invention. However, that is not a correct statement of the law on the written description requirement of § 112, which has been held to be separate from and

performs a different function than the enablement requirement.³ Manifestly, one cannot describe the invention claimed by omitting disclosure from the specification which would reasonably convey to one skilled in the art that, at the time the invention was filed, applicant was possessed of the thing later claimed by them. Further, the written description requirement of the statute is satisfied by describing the invention as claimed and not by disclosing that which would have made the claimed invention obvious. Lockwood v. American Airlines Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Moreover, U.S. Patent Number 5,008,041 cited by appellants at page 3 of their request was not relied on by appellants in their brief or even cited in the prosecution of their application. Therefore, we shall not consider it now for the first time on rehearing.

We affirmed the examiner's rejection of claim 24 under § 112, for failing to satisfy the written description requirement of the statute because, as correctly noted by appellants in their request, appellants' disclosure only conveyed that appellants described a method for forming crystalline electrically conductive precursors (undoped polymers) or crystalline electrically conductive polymers (doped polymers) prepared from

³ Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

polymers without any unreacted monomer or catalyst⁴. Thus, claim 24, which depends on claim 1 and which neither recites nor requires any unreacted monomer or catalyst, is directed to subject matter not "described" in appellants' disclosure in the sense of the statute.

None of the examples in appellants' disclosure specifically recites the presence of any "monomer of said precursor" or an "oxidant." Neither do appellants' examples reasonably convey that appellants included any "monomer of said precursor" or an "oxidant." Thus, appellants' response to our finding (see the first full paragraph on page 4 of Paper Number 17) that their method could include "monomer of said precursor" and an "oxidant" is mere conjecture. We adhere to our findings that the reasonable interpretation of appellants' disclosure which the person of ordinary skill in the art would have made at the time appellants filed their application was that after the precipitation of the polymer from solution, after neutralization of the precipitated polymer, after filtration, washing and drying of the precipitated and neutralized polymer, there would have been no reasonable expectation that any unreacted monomer or "oxidant" remained in

⁴ A "precursor to an electrically conductive polymer" as required in claim 1 is described in appellants' disclosure as "polyaniline in the non-doped" form. See page 10, lines 11 through 13 of the specification.

the polyaniline so-prepared. Indeed, we take official notice of the fact that the ammonium peroxydisulfate "oxidant" used in the example on page 15 of the specification is highly soluble in water and would have been expected to have been removed with the aqueous phase during the filtration step and the subsequent washing step.

In affirming the examiner's rejection of claim 24 under § 112, we found that claim 24 originally recited:

A method according to Claim 1, wherein said admixture contains a polyaniline monomer, said additive and an oxidant.

Claim 1, although open to the inclusion of other components, neither recited nor required any monomer or "oxidant". Original claim 24 required that in the method of claim 1 there was present in addition to the "solvent", "an additive" and "a polymer", a "polyaniline monomer" and an oxidant. Thus, although claim 1 on which claim 24 depends neither recited nor required any specific polymer let alone "polyaniline", original claim 24 required in addition to the mixture in claim 1 a specific monomer of a specific polymer. As we found at page 9 of our decision, amended claim 24 recited the method of claim 1 but wherein "said admixture further includes monomer of said precursor and an oxidant." Thus, amended claim 24 required a monomer of the "precursors" (the undoped polymers) required in claim 1.

Accordingly, amended claim 24 required not only the recited doped or undoped polymers of claim 1 but also "monomer of said precursor." Thus, appellants' argument that amended claim 24 "essentially recites the same admixture in the method as is recited in non-amended original claim 24" is factually erroneous.

On pages 5 through 7 of their request, appellants argue that in affirming the examiner's alternative rejection of claims 1 through 16, 20, 22, 23 and 25 under 35 U.S.C. §§ 102 or 103 as it was founded on Han we improperly "mixed" the terminology of the references with the terminology of appellants' disclosure with respect to the "solvent" and "additive" required by appellants' claims. We disagree. In the first instance, we explained on pages 7 and 8 of our decision that, except for independent claim 11, there were no separate arguments advanced in appellants' brief with respect to particular limitations in particular claims and that, except for claim 11, the patentability of all the claims stood with the patentability of claim 1.

On page 9 of our decision, we construed the meaning of the term "solvent" in light of its recitation in claim 1 and appellants' disclosure at page 11 of their specification of useful organic and aqueous solvents. Likewise, we construed the meaning of the term "an additive" in light of appellants' disclosure and the specific "additives", that is, plasticizers

disclosed as useful in appellants' disclosure. We found, and appellants do not dispute in their request, that Han taught mixing N-methyl pyrrolidinone, one of appellants' preferred solvents, tripropylamine, a plasticizer and, thus, "an additive" as required by claim 1 and electrically conductive polyaniline. We also found, and appellants do not dispute in their request, that Cao taught admixing a polyaniline polymer with xylene, a solvent, and dodecylbenzene sulfonic acid, one of appellants' "plasticizers and, thus, "an additive". We also found that both Han and Cao taught removal or partial removal of the solvent from the admixtures disclosed. Thus, we cannot comprehend on what basis appellants allege to distinguish the facts here from the facts in the decisions in In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934, (Fed. Cir. 1990); In re Spada, 911 F.2d 705, 15 USPQ2d 1655, (Fed. Cir. 1990); and, In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) cited by us in our decision affirming the examiner's alternative rejection.

THE NEW GROUNDS OF REJECTION

As correctly observed by appellants in their request, in our decision we newly rejected claims 40 through 42 under §§ 102 or 103 of the statute over the same prior art over which the affirmed claims were rejected but under our express authority under 37 C.F.R. § 1.196(b). On page 20 of our decision, we

specifically found that:

the prior art describes a method in which electrically conductive anilines, solvents and certain compounds, including some of the same, specific compounds used in appellants' method are "admixed." Whether named "plasticizers" or "oxidants" or "diluent" or even simply a "second material", the fact remains that appellants admix the same compounds as the prior art "admixes" and it is, therefore, reasonable to presume that appellants obtain the same materials as the prior art obtains.

Appellants' only response to this rejection is found at page 8 of their request wherein they repeat the argument we have expressly rejected above, that is, that claim 40 requires that the "additive" is an "oxidant" and the "oxidant" is left over from the polymerization reaction used to prepare one of the other ingredients in claim 1, that is, the "polymer."

Nevertheless, we observe here that Cao at column 10, lines 13 through 42 describes how the polyanilines of their invention may be prepared. Significantly, Cao discloses oxidative polymerization using ammonium persulfate, the same "oxidant" allegedly used by appellants and alleged by appellants to be present in their "polymer". Han includes a similar disclosure at column 14, lines 19 through 45. See, also, column 6, lines 23 through 42 of Eisenbaumer. Thus, under the same reasoning set forth in the cases on which we relied in our decision and assuming, *arguendo*, that some residual "oxidant" remains in the prior art polymers, appellants are claiming only that which the

prior art discloses.

Appellants address our separate new ground of rejection of the claims over the disclosure of Eisenbaumer by directing our attention to their disclosure at page 11 of their specification wherein the morphology of polymers is discussed. Appellants then allege that the type of polymers prepared by the methods taught by Eisenbaumer lack the morphology of the polymers prepared according to the claimed method.

In the first instance, the discussion at pages 11 and 12 of the specification concerning the morphology of polymers does not discuss or reference in any fashion the disclosure of Eisenbaumer. Rather, the discussion concerns polyaniline films prepared by spin-coating or solution casting, in general. Thus, there is not, as appellants' argument suggests, any comparison, direct or otherwise, of polymers prepared by the claimed method compared with polymers prepared by the method of Eisenbaumer. Further, all the appealed claims are directed to a method for preparing polymers by mixing certain ingredients in a solvent and subsequently removing all or part of the solvent. This is precisely what is shown and described by Eisenbaumer (see the paragraph bridging pages 20 and 21 of our decision).

CONCLUSION

In our decision on pages 22 and 23, we explained to appellants the various options by which they could proceed in this appeal. With respect to the affirmed rejections, appellants elected to file a request for rehearing. With respect to the new grounds of rejection, appellants eschewed submission of an appropriate amendment of the newly rejected claims or submission of a showing of facts and remand to the examiner for further prosecution. Rather, appellants chose to proceed by requesting rehearing by the Board based upon the existing record. Accordingly, further prosecution before the examiner is no longer available as an option in responding to our decision as set forth in Paper Number 16 and this decision may be considered final for purposes of judicial review as of the date of mailing of this decision.

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Accordingly, appellants' request has been granted to the extent we have reviewed and reconsidered our decision in light of appellants' request for rehearing but it is otherwise denied because we decline to modify our decision in any respect.

DENIED

Edward C. Kimlin

EDWARD C. KIMLIN)
Administrative Patent Judge)

Andrew H. Metz

ANDREW H. METZ)
Administrative Patent Judge) BOARD OF PATENT
APPEALS AND
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Peter F. Kratz

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